REMARKS

This is a response to the Office Action dated July 6, 2005. Claims 1-20 are pending in the application. Claims 1-19 were rejected under 35 U.S.C. § 102(b) as being unpatentable over U.S. Pat. No. 4,878,713 ("Zanetis"). The grounds for rejection are believed to be overcome in view of the remarks presented below.

The rejections from the Office Action dated July 6, 2005 are discussed below in connection with the various claims. No new matter has been added. Reconsideration of the application is respectfully requested in light of the following remarks.

Rejections Under 35 U.S.C. § 112

Claims 4 and 9-19 were rejected under 35 U.S.C. § 112 as being allegedly indefinite. Claims 4, 10, and 14 have been revised, replacing the term "similar" with the term "equal." In addition, claim 9 has been revised so that the recitation "the first-side portion" has been replaced with the "the second-side portion," and the term "it" has been replaced with "the shaft." Accordingly, Applicants request that the Examiner withdraw these rejections.

Rejections Under 35 U.S.C. § 102(b)

Independent Claim 1

Independent claim 1 was rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Zanetis. Applicants have amended claim 1 to more clearly describe the invention. Independent claim 1, as amended, relates to an implement having a housing with a first-side portion and a second-side portion. A driving element having a weight is attached to the second-side portion, with the weight creating a moment arm. A shaft is positioned between the first-side portion and second-side portion and is operably coupled to the driving element. A non-driving counterweight is attached to the first-side portion of the housing and offsets the moment arm created by the weight of the driving element.

According to the Examiner, Zanetis teaches an implement including "a shaft 51 or 44 positioned between the first-side portion ... and second-side portion ... of the housing 21 and operably coupled to at least one of the element 50; and a counterweight 43,

45 attached to the first-side portion ... of the housing 21, the counterweight 43,45 offsetting the moment arm ... created by the weight ... of the element 50."

Applicants respectfully disagree with the Examiner's construction that the bearing ring 43 and the enlarged flange-like head 45 in Zanetis is a counterweight offsetting the moment arm created by the hydraulic motor 50. Zanetis makes no mention of any moment arm created by the weight of the hydraulic motor 50 or of any offsetting counterweight. As seen in Figs. 2 & 9, the digging instrumentality or cylindrical drum 20 in Zanetis appears to have a relatively large distributed weight compared with the hydraulic motor 50. This distributed weight of the drum 20 would evenly distribute the moment about the rotational axis of the planning machine 5, and eliminate the need for the claimed counterweight.

In contrast, claim 1, as amended requires a non-driving counterweight attached to the first-side portion of the housing that offsets the moment arm created by the weight of the driving element. The weight of the claimed driving element is localized at the second-side portion of the housing, creating a moment arm that is offset by the non-driving counterweight.

Because Zanetis does not teach or suggest providing a non-driving counterweight offsetting the moment arm created by the weight of the driving element, Applicants respectfully submit that Zanetis does not anticipate the present invention. Accordingly, Applicants request that the Examiner withdraw this rejection of independent claim 1.

Independent Claims 9 and 14

The Examiner has also rejected independent claims 9 and 14 as being anticipated by Zanetis. Independent claim 9, as amended, relates to a method including the steps of attaching a motor having a weight to a second-side portion of the housing and attaching a non-driving counterweight to the first-side portion of the housing. The motor being attached to the second-side portion of the housing creates a moment arm, and the non-driving counterweight offsets the moment arm created by the motor.

Independent claim 14, as amended, relates to a work machine comprising an implement including a motor attached to a second-side portion of a housing and a non-driving

counterweight attached to a first-side portion of the housing, where the non-driving counterweight has a weight substantially equal to that of the motor.

As discussed above for independent claim 1, Zanetis does not teach or suggest attaching a non-driving counterweight that offsets the moment arm created by the motor or providing a non-driving counterweight having a weight substantially equal to that of the motor. Because Zanetis does not teach or suggest attaching a non-driving counterweight that offsets the moment arm created by the motor, Applicants respectfully submit that Zanetis does not anticipate the present invention. Accordingly, Applicants request that the Examiner withdraw this rejection of independent claims 9 and 14.

Dependent Claims 2-8, 10-13, and 15-19

Dependent claims 2-8, 10-13, and 15-19 were also rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Zanetis. The dependent claims should be allowed for at least the reasons set out above for claims 1, 9, and 14, the claims from which they depend. Applicants therefore request that the Examiner withdraw this rejection of these claims.

Further, Applicants submit that claims 4, 7, 8, and 12, as amended, are also not anticipated by Zanetis, as this reference fails to teach or suggest all of the elements of these claims.

For claim 4, Zanetis makes no mention of any weight associated with the counterweight 43, 45. While the elements 43 and 45 identified by the Examiner would have some weight, nothing in Zanetis discloses that the elements 43 and 45 have a weight substantially equal to the weight of the motor 50. As discussed above for claim 1, a counterweight having a weight substantially equal to the weight of the motor would not be needed in Zanetis due to the large distributed weight of the digging instrumentality or cylindrical drum 20. (See Zanetis, Figs. 2 & 9).

For claim 7, Zanetis does not teach or suggest adjustably attaching the second plate to an inner side of the first-side portion of the housing. As seen in Fig. 8, Zanetis directly attaches head 45 to the outer surface of sidewall 26. However, bearing ring 43 is rotatably attached to stub shaft 44 – not the inner surface of sidewall 26. (*See* Fig. 8, Col. 6, ll. 22-41). This attachment of Zanetis limits the adjustability of elements 43 and 45 so that those elements move perpendicular to the sidewall 26. In contrast, as described in paragraph

17 of the Specification, "[a]djusting the location of the attachment of the counterweight 297 to the first-side portion 215 of the housing 210 permits the shaft 245 to align with the motor 260." (See Specification, ¶ 17).

For claim 8, Zanetis does not not teach or suggest that the adjustability of the first and second plates parallel to the first-side portion of the housing permits the shaft to align with the motor. As described above for claim 7, Zanetis limits the adjustability of elements 43 and 45 so that those elements move perpendicular to the sidewall 26.

For claim 12, Zanetis does not teach or suggest attaching a second plate to an inside of the first-side portion of the housing. See the discussion above for claim 7 for details.

New Claims

With this response, new claim 20 has been added. Support for this claim may be found in the Specification at paragraph 17, for example. No new matter has been added. New claim 20 should be allowed over the cited references for the same reasons as discussed above. Accordingly, Applicants request that the Examiner allow new claim 20.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections, and that they be withdrawn. The Examiner is courteously invited to telephone the undersigned representative if it is believed that an interview might be useful for any reason.

Respectfully submitted,

Steve D. Lundquist
Registration No. 42,816
Caterpillar Inc.

Telephone: (309) 675-4460
Facsimile: (309) 675-1236